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IN THE  
**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT, *p*

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No. 6996

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OTIS ELEVATOR COMPANY,  
*Plaintiff, Appellant and Cross-Appellee,*

*vs.*

PACIFIC FINANCE CORPORATION AND LLEWELLYN  
IRON WORKS,  
*Defendants, Appellees and Cross-Appellants.*

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AFFIDAVIT OF WALLACE R. LANE AND EXHIBITS A, B AND C  
REFERRED TO THEREIN FILED IN SUPPORT OF  
PETITION FOR REHEARING.

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WALLACE R. LANE,  
WILLIAM H. HUNT,  
EDWIN W. SIMS,  
CLARENCE J. LOFTUS,  
RAYMOND IVES BLAKESLEE,  
*Counsel for Petitioner, Otis  
Elevator Company.*

**Filed**

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## INDEX.

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	Page
Affidavit of Wallace R. Lane and Exhibits A, B and C Referred to Therein Filed in Support of Petition for Rehearing .....	1
“Exhibit A” .....	12
Plaintiff’s Exceptions and Suggestions Made to The Master’s Draft Report, Filed January 13, 1930, Concerning the Validity of Claim 37 of the Parker Patent as a Sub-Combination Claim and the Authorities Filed in Support Thereof .....	12
There is no Suggestion in it That Plaintiff Was Aware That the Master Regarded This Claim Invalid as Functional Only .....	12
A Sub-Combination Claim Need Not Specify a Complete Operative Machine .....	15
“Exhibit B” .....	21
Plaintiff’s Brief in Resistance to Motion to Dismiss, Dated June 17, 1931.....	21
Statement .....	21
Under the Statutes and Authorities Applicable a Disclaimer is Necessary Only Where a Patentee Has Claimed More Than That of Which He was the First Original Inventor or Discoverer and This Does Not Have to be Filed Until After the Entry of a Final Decree by a Court of Competent Jurisdiction.....	29
The Failure to File a Proper But Unnecessary Disclaimer is not Injurious to the Remaining Claims Under the Statutes and Authorities Applicable, But May be Filed Any Time Before the Expiration of the Patent at the Patentee’s Election .....	32

The Ensten Case, 282 U. S. 445, Upon Which Defendant Relies, Does Not Support Defendants' Motion. It Does Not Apply to the Situation Here.....	37
The Exception to the General Rule is That No Exceptions Need Be Filed to the Legal Conclusions of a Special Master .....	43
The Filing of a Disclaimer is Not a Confession That a Patent Would be Void if the Disclaimer Were Not Made	48
Conclusion .....	49
<b>"Exhibit C"</b> .....	50
Defendants' Exceptions to Master's Report Involving Claim 37 .....	50

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STATE OF ILLINOIS,    }  
COUNTY OF COOK.    } ss.

Wallace R. Lane being first duly sworn states that:

He has represented the Otis Elevator Company as its counsel in this litigation continuously since the bill of complaint was filed on June 6, 1927.

January 21, 1929, on defendants' motion over plaintiff's protest, the trial Court referred the case to a Master to make and report findings of fact and conclusions of law.

February 27, 1929, plaintiff believing that this reference was not in compliance with Federal Equity Rule 59, (*Los Angeles Brush, etc. v. James*, 272 U. S. 701), and that the expense and delay incident to such a reference would be seriously prejudicial to the plaintiff, filed a petition to have the order of reference set aside.

March 2, 1929, the trial Court denied this petition and stood by its original order of reference.

That much uncertainty and unnecessary delay and expense in this litigation has been due to the fact that this case was referred to a Master, upon defendant's insistence.

April 3 to 16, 1929, continuous hearing before the Master.

December 18, 1929, the Master submitted to counsel for the respective parties a "preliminary draft" of his report to permit him to consider such exceptions and suggestions for amendment as might be offered. (See Master's report R. 590.) In this draft report the Master indicated that he proposed recommending that Parker be held to have made a highly meritorious invention, and that the claims asserted, 3, 22, 29, 40 and 65 were valid and infringed, that claim 41 was valid but not infringed, and that claim 37 was invalid because it was not sufficiently definite to comply with Section 4888 of the Revised Statutes.

January 13, 1930, plaintiff made certain suggestions to the Master's draft report and insisted, as it now does, that claim 37 was a proper sub-combination claim. Plaintiff then pointed out that this sub-combination consists of a control system for an electric elevator comprising—

- (1) a *plurality* of *up* switches *within* the car, *one* for *each* of a *plurality* of landings,
- (2) a *plurality* of *up* switches *without* the car, *one* at *each* of said landings,
- (3) a *plurality* of *down* switches *within* the car, *one* for *each* of said landings,



- (4) a *plurality* of down switches *without* the car, *one at each* of said landings,
- (5) *switching mechanism within* the car.

Plaintiff also showed that the language used to make plain the operation of the first four elements;

that both the up and down switches within the car and at each landing were operable to "cause the stopping of the car at the respective landings upon its approaching said landings" in both the up and down direction,

and

that used to make plain the operation of the fifth element that "said switching mechanism being operable to cause the starting of the car from each and every landing in either direction"—

"plainly imports into it *the circuits and circuit closing means* through which—

'the starting of the car from each and every landing in either direction',

"is caused, and—

'the stopping of the car at the respective landings upon its approaching said landings'

"in the up and down direction, is caused."

Plaintiff also there insisted:

"It is not necessary that the mechanism covered by a sub-combination claim is operable *per se* for such claim always draws to itself the structure and means, or its equivalent, shown in the drawings and pointed out in the specifications."

A complete copy of plaintiff's contentions with respect to claim 37 and the authorities filed before the Master January 13, 1930, in support thereof, is attached hereto and made a part hereof as "Exhibit A."

The Master, in his final report with respect to these suggestions made by plaintiff, says (R. 590)—

"*The plaintiff excepted* to the findings on claims 37 and 41. No reason has been found to change these findings, although the report has been amended in an effort to clarify the master's findings on claim 41.

"The defendants' exceptions, other than those that are formal in character, are directed to the omission

of specific findings on certain prior art structures. These omissions are intentional. Those references upon which no findings are made are not considered to be pertinent. If this view is erroneous, it would not assist in correcting the error to include in the report findings made upon what the master considers irrelevant matter. *Should there be error, the findings can be made after the error is pointed out and corrected.*"

February 25, 1930, the Master filed his final report containing a number of the typographical changes suggested, but adhered to the findings of his draft report save as above indicated. His language in the draft report is the same as that in his final report concerning claim 37, concerning which he says (R. 590):

"The plaintiff excepted to the findings on claim 37."

When the Master's report was filed the question was presented to plaintiff's counsel, for the first time, as to whether, in view of the statement of the Master concerning claim 37 (R. 570-1):—

"It must also be considered that the other claims amply protect the invention. It is concluded that Claim 37 does not comply with Section 4888 of the Revised Statutes and is, therefore, invalid,"

it was necessary to take any further steps with respect to this claim or with respect to claim 41, which the Master concluded was not infringed, in order to adequately protect plaintiff's invention and its rights with respect to these claims.

After a full conference among the attorneys representing the plaintiff, and a careful analysis of claim 37 and all of the language of the Master with respect thereto, the conclusion was unanimously reached that while claim 37 was a proper sub-combination claim, and that as the Master had concluded that it was invalid only because it did not comply with Section 4888 of the Revised Statutes, due to his conclusion that the circuits and circuit closing means should have been included in the claim, as a (R. 570)—



“claim must include such definition of structure that the elements of the structure claimed can be identified,”

and as the other claims did amply protect the invention, time and expense to the court and litigants would be saved by neither filing any further exceptions to the Master's report, nor making any argument before the trial Court with respect to claims 37 and 41.

It was also decided that should the Court, after reviewing the Master's report, conclude that claim 37 was invalid for the reason stated by the Master, or for the reason presented by the defendants before the Master that it was for an aggregation and therefore invalid, plaintiff could, under the decisions that such a question of law could be considered by the trial Court without exceptions to the Master's report, attempt to prevent the entry of a decree consonant with such holding, and if a decree were then entered over plaintiff's protest holding this claim invalid, an appeal could be taken from such decree by plaintiff.

The conclusion was also reached among plaintiff's counsel, in view of the authorities and decisions then carefully considered, that the Master's report was at large, and that the question of law as to whether claim 37 was sufficiently definite to comply with Section 4888 of the Revised Statutes could be considered by the Court at any time prior to the entry of its decree without the filing of further exceptions.

October 15, 1930, the hearing on the defendants' exceptions to the Master's report was argued before Judge James.

In these exceptions defendants themselves raised the question of validity of claim 37 on other grounds than those suggested by the Master, and insisted that the Master erred in failing to find that claim 37 was invalid because—

(a) anticipated by the patent to Strohm (Exception 61);

- (b) for an aggregation (Exception 76);
- (c) for a different invention than claimed in the original Letters Patent (Exception 111);
- (d) of intervening rights by defendants (Exception 115);
- (e) of unreasonable delay in filing application for reissue (Exception 122); and that
- (f) this and other claims of the patent in suit cover merely the function or abstract effect of a machine (Exceptions 30, 31, 32, 33).

Defendants thereby clearly show that they had no thought that the Master had held claim 37 invalid *because it covered only a function*. On the contrary they insisted by their exceptions that the Master was wrong because he did not so hold. They insisted that the trial Court *should reverse the Master because he did not hold the claim was for a function or abstract effect* of a machine. They also insisted that the trial Court should also hold that this claim was invalid because it was anticipated, was for an aggregation, was for a different invention than the original patent, because of unreasonable delay in filing application for reissue, and of intervening rights.

The question of invalidity of claim 37 was thus before the trial Court on nearly every ground available to a defendant except that it did not comply with Section 4888 of the Revised Statutes under defendants' own exceptions.

From the papers on file in this case, and so far as I am advised, there was no thought, expressed or implied, that anyone considered the Master's opinion with respect to claim 37 as holding that it covered a function only until the filing of the opinion of this Court.

As the defendants' exceptions to the Master's report are not before the Court, I attach hereto a correct copy of those referred herein, as "Exhibit C."

It was not until October 2, 1931, nearly a year after the argument, that the trial Court handed down its opinion

holding claims 3, 22, 29, 40, 41 and 65 of the Parker patent valid but not infringed. November 30, 1931, the decree of the trial court was entered.

While the Master's report was at large and under consideration by the trial Court, the Supreme Court handed down its decision in the Ensten case, which it took on Petition for certiorari on account of divergency of opinion between Courts of Appeals of different circuits with respect to disclaimers. Upon learning of this decision, a conference between plaintiff's counsel was had, with the view of determining whether the situation as above presented required either—

- (a) Calling attention of the trial Court to claim 37, and asking it to pass upon the validity of claim 37; or
- (b) Whether a disclaimer should or could be filed.

After careful consideration of the decisions with respect to the Master's report being at large until passed upon by the trial Court, and those holding that a court could either of his own volition or upon his attention being called particularly with reference to matters of law, change or modify the report in any way he saw fit, counsel reached the unanimous conclusion that the question of the validity of claim 37 could then be called to the attention of the Court, and the Court could thereafter pass upon it. However, as the Master had held and as the fact is, that the other claims adequately protect the Parker invention, the further conclusion was reached that there was no necessity of spending further time of the Court and litigants with respect to claim 37. For these reasons it was decided not call the Court's attention to this claim, but instead to consider whether any disclaimer was proper, advisable or necessary.

In this connection, counsel for plaintiff thoroughly canvassed the Ensten case and all other available decisions and textbook reports, and other authorities, with respect

to disclaimers, with the view of determining whether it was advisable, proper or necessary to file a disclaimer of claim 37. As a result of extended investigations and the value of claim 37, in view of the other claims of the Parker patent, it was decided:

*First.* That claim 37 was a proper and valid sub-combination claim and under the opinion of the Master, covered no more than that of which Parker was the first and original inventor and discoverer, but as the other claims adequately covered the invention; the expense of contesting the finding of the Master that this claim was indefinite, was unjustified;

*Second.* That as the Master's report simply indicated that the claim was indefinite as not complying with Section 4888 of the Revised Statutes, and as he had not held that this claim covered more than that of which Parker was the first and original inventor or discoverer, that no disclaimer whatever was necessary and there was very grave question as to whether it was even proper under the disclaimer statutes;

*Third.* That while it was clear that no disclaimer was necessary, it was decided to file one, as the other claims adequately protected the invention, and thus eliminate the necessity of any further consideration of this claim by any court.

It was thus concluded that if a disclaimer should be filed both defendants and plaintiff would be relieved from further controversy in the trial Court or anywhere else over the question of validity or infringement of this claim. It was also concluded that in filing a disclaimer, plaintiff would in no wise prejudice its rights under the patent.

May 1, 1931, six and one-half months after the case had been argued before Judge James, and five months before he had rendered his opinion, and seven months before the filing of the decree below, plaintiff filed a disclaimer of claim 37. In this disclaimer plaintiff stated (R. 631):

*"The sole reason for this disclaimer is that a Special Master, in the case of Otis Elevator Company v. Pacific Finance Corporation and Llewellyn Iron*



*Works, now pending in and undecided by the District Court of the United States, for the Southern District of California, Central Division, has advised, for reasons likewise applicable to claims 34, 35 and 36, in a report filed by him, that said claim 37 is invalid as not complying with Section 4888 of the Revised Statutes, and as he 'considered that the other claims amply protect the invention.' "*

All of the above steps were taken by plaintiff only after thorough and mature consideration of the claim, the Master's report, and the circumstances existing in this case. While there were a number of conferences about the questions involved, no one expressed or intimated the thought that either the claim or the Master's report indicated that claim 37 was "invalid because it claims only the function or result of an invention." This statement is supported by the disclaimer itself and by the affidavit of Mr. Walter E. F. Bradley, the Patent Engineer of the Otis Elevator Company, who was among those who conferred with respect to the filing of the disclaimer, filed in this case on July 20, 1931, sworn to on July 14, 1931, in which he stated with respect to the disclaimer of claim 37:—

"This disclaimer was filed by the plaintiff not because the patentee claimed more than that of which he was the first or original inventor, and not because plaintiff did not believe claim 37 set forth a proper sub-combination. Plaintiff elected as a matter of policy not to retain claim 37 as the invention therein referred to was amply covered by other claims as found by the master in this case, and because the master was of the opinion it was indefinite and did not comply with Section 4888 R. S."

In all of the conversations concerning the steps to be taken, the questions related to whether the claim was a proper sub-combination claim, and whether it was invalid because not sufficiently definite to comply with Section 4888 of the Revised Statutes, and the conclusions above stated were reached with respect to these premises.

June 17, 1931, defendants filed a motion to dismiss the bill of complaint on the sole ground that the entire patent

was invalid because claim 37 was invalid under Section 4888 of the Revised Statutes and of unreasonable delay in filing a disclaimer, and on June 22, 1931, filed a brief in support thereof (R. 622).

July 20, 1931, plaintiff filed a brief in resistance to defendants' motion to dismiss filed June 17, 1931.

As this court stated in its opinion:

"Plaintiff asserted in answer thereto [defendants' motion] that the disclaimer was timely and sufficient thereunder. *It now urges in addition* that no disclaimer was necessary" etc.,

I hereby attach a copy of the brief then filed as "Exhibit B," so that the Court may correct its misapprehension that we have not at all times urged that no disclaimer was necessary though proper. This brief was filed by plaintiff before the trial Court in resistance to defendants' motion to dismiss. It shows:—

(1) That plaintiff urged that no disclaimer was necessary though proper;

(2) That claim 37 was a proper one and sufficiently definite as a sub-combination claim to comply with Section 4888 of the Revised Statutes under the authorities applicable;

(3) That notwithstanding this, before any finding of the trial Court was made or any final decree entered, plaintiff filed a proper but not necessary disclaimer as to claim 37;

(4) That "The sole reason for filing this disclaimer" was that the Master's report had concluded that "claim 37 is invalid as not complying with Section 4888 of the Revised Statutes," and as he considered that "the other claims amply protect the invention;" and

(5) That the master recommended that the claim be held invalid:—

(a) Not because Parker claimed "more than that of which he was the original or first inventor or discoverer";

(b) Not because he claimed "materially more than that of which he was the first to invent";

(c) Not because he claimed to be the first, original inventor or discoverer of a substantial



part of a thing of which he was not the original or first discoverer, for the Master definitely found, as shown on the face of his report, "that the other claims amply protect the invention",

but because he ruled, as a question of law, that claim 37 did not comply with Section 4888 of the Revised Statutes as to form, for it did not include "such definition of structure that the elements of structure claimed can be identified."

The trial Court was thus given an opportunity to pass upon the validity of claim 37 in determining whether a disclaimer was necessary or not. Instead of this, the trial Court held in its opinion, filed October 2, 1931, that as the matter was at large and the Court could consider the question of the validity of this claim had plaintiff not disclaimed, plaintiff had not forfeited any rights by failure to except to the Master's report.

So far as I am advised, since the Master submitted his draft report to counsel for the parties for their suggestions and exceptions no one, prior to the opinion of this Court, has suggested or argued that the Master concluded or intended to intimate that claim 37 of the Parker patent was invalid as functional only, but simply that he regarded it as not sufficiently definite to comply with Section 4888 of the Revised Statutes. Plaintiff's counsel has always insisted and firmly believes that claim 37 was a proper sub-combination claim and that the finding of the master with respect thereto did not require the filing of a disclaimer, but that it had the right to disclaim to save further controversy over that claim as the other claims amply protect the Parker invention and would not be prejudiced thereby.

WALLACE R. LANE.

Subscribed and sworn before me a Notary Public, this 18th day of February, A. D. 1934.

IRENE V. CURRAN,  
*Notary Public.*  
 (NOTARIAL SEAL)

“EXHIBIT A.”

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PLAINTIFF'S EXCEPTIONS AND SUGGESTIONS MADE TO THE MASTER'S DRAFT REPORT, FILED JANUARY 13, 1930, CONCERNING THE VALIDITY OF CLAIM 37 OF THE PARKER PATENT AS A SUB-COMBINATION CLAIM AND THE AUTHORITIES FILED IN SUPPORT THEREOF.

THERE IS NO SUGGESTION IN IT THAT PLAINTIFF WAS AWARE THAT THE MASTER REGARDED THIS CLAIM INVALID AS FUNCTIONAL ONLY.

*Claim 37.* We respectfully suggest that the Master reconsider the statement on pages 22 and 23 concerning claim 37, for we feel that the language of this sub-combination claim plainly imports into it the circuits and circuit closing means through which—

“the starting of the car from each and every landing in either direction”,

is caused, and—

“the stopping of the car at the respective landings upon its approaching said landings”

in the up and down direction, is caused. It is not necessary that the mechanism covered by a sub-combination claim is operable *per se* for such claim always draws to itself the structure and means, or its equivalent, shown in the drawings and pointed out in the specifications.

We blame ourselves for not pointing out with more particularity the sufficiency of this claim either in our original or reply brief. The Patent Office having considered the claim sufficiently descriptive to comply with the statutes, and the defendants making no contention to the effect that it did not, caused us to overlook this.

It is true that so far as defendants' infringement is concerned, other claims which have been sustained and held infringed by the Master amply protect the invention, but as the claim is clearly for a novel subject matter and is not

met by the art, we dislike to acquiesce in holding this claim invalid under Section 4888, as it may seriously prejudice plaintiff's rights in other litigations.

Analysis of the claim shows that it is for a *control system* for an elevator car. The words "control system" alone compels reference to be made to the specifications and drawings to ascertain the character of the system and the means to be employed in connection with the sub-combination of elements. When reference is thus made, it is immediately apparent that the switches are a part of an operable combination which necessarily include the primary and secondary circuits through which the car is started, run and stopped. Furthermore, the expressions—

"operable to cause the stopping of the car at the respective landings upon its approaching said landings in the up direction,"

used in connection with the up switches within and without the car;

"operable to cause the stopping of the car at the respective landings upon its approaching said landings in the down direction,"

used in connection with the down switches within and without the car; and

"being operable to cause the starting of the car from each and every landing in either direction,"

used in connection with the switching mechanism located within the car, each clearly indicates, to anyone experienced in the elevator art, the operative circuits and means whereby the car is run and stopped, the starting and running being initiated by switches within the car, and the stopping in either direction being initiated by switches within the car and at the landings.

The claim is for a *control system* for an elevator car, and has positively included as elements:—

(1) up switches within the car and without the car for causing the car to stop at the respective landings in the up direction;

(2) down switches within the car and without the car for causing the car to stop at the respective landings in the down direction;

(3) switching mechanism within the car to cause the starting of the car from each and every landing in either direction.

The sub-combination of elements in the control system for elevator cars covered by claim 37 are clearly operable in connection with the circuits and circuit closing means shown and described in the drawings and specifications, and can be readily identified by reference thereto. This, under the authorities, is sufficient to satisfy the requirements of Section 4888 of the Revised Statutes as we understand it, and the decisions of the court which have interpreted it. This would be true even though no reference in the claim were made to the elements being used in a "control system", and even though the words "operable to cause the stopping of the car" and "operable to cause the starting of the car" were not used as they are in the present claim, for the elements in a sub-combination claim in a patent do not have to be operable *per se*, so long as they are operable in connection with the disclosures of the patent.

The provisions of Section 4888 relate simply to the requisites of an application which an inventor must file in order to receive a patent for his invention. When he has shown in his drawings, description and claims the manner of making, constructing and using it in such—

"terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same,"

and has distinguished it from other inventions, he has satisfied the requirements of this statute. It is apparent from the record and from the decision of the Master that the disclosures of the Parker patent are ample to fully satisfy these requirements. Having done so, and the public having available to it the complete drawings and spec-



ifications, and the means and apparatus shown therein, an inventor may properly cover sub-combinations in different claims, less than the whole invention, and even though this sub-combination is operable in connection with other operable parts of the system, the claim is nevertheless valid, and the infringer is not entitled to use the sub-combination thus claimed.

In connection with the foregoing, we respectfully call the Master's attention to the following authorities fully supporting our position, and to which we made no reference in either of our briefs filed following the hearing, as the question of sufficiency of this claim had not at that time been raised by anyone. As claim 37 is in the form of a number of sub-combination claims which have been sustained by the courts, and as the Patent Office had considered it sufficiently definitive of the invention, we hope that our failure to point out the foregoing considerations, as well as the following decisions, will not prevent the Master giving the matter careful reconsideration.

The adoption by the Master of the suggestions we have made concerning claim 37 will necessitate only a revision of the full paragraph starting at the bottom of page 22 and ending the middle of page 23.

**A SUBCOMBINATION CLAIM NEED NOT SPECIFY A COMPLETE OPERATIVE MACHINE.**

Claim 37 amply complies with Section 4888 and is clearly *valid as a sub-combination* under the authorities.

Judge Hazel in *Wright v. Curtiss*, 204 Fed. 597, at page 607, in disposing of a similar contention there made and holding the claim valid and infringed, said:

“It is not essential to the validity of claim 3 that all parts of the machine, or all parts specified in other claims, which are necessary to its operativeness, should be included therein, and resort must be had to the spec-

ification for a disclosure of the parts necessary to insure the practicability of a patented device. In the Wright structure a new and novel result was attained simply by having the ailerons on the ends of the planes, without the supplemental feature of the vertical rudder. The warping feature is, in fact, the essential part of the machine, while the vertical rudder, insuring successful flying, is a valuable adjunct, without which lateral balance could not be restored. The employment, in a changed form, of the warping feature or its equivalent by another, even though better effects or results are obtained, does not avoid infringement. In such circumstances, as I read the authorities, the claim is valid as a subcombination. *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759, 68 C. C. A. 461; *Deering v. Winona Harvester Works*, 155 U. S. 286, 15 Sup. Ct. 1187, 39 L. E. 153; *Taylor et al v. Sawyer Spindle Co.*, 75 Fed. 301, 22 C. C. A. 203. In *Railroad Co. v. Dubois*, 12 Wall. 47, 20 L. Ed. 265, the Supreme Court of the United States says:

“ ‘Undoubtedly a patentee may claim and obtain a patent for an entire combination, or process, and also for such parts of the combination or process as are new and useful, and he may claim and obtain a patent for both.’

“ ‘In *Thomson-Houston Electric Co. v. Black River Traction Co.*, *supra*, Judge Wallace, writing for the Circuit Court of Appeals said:

“ ‘Many subcombinations, although new, are not useful, except to perform their appropriate functions in the machine of which they are a part. The description in the patent of the whole machine, and of the means or mode by which the subcombination is brought into co-operative relation with the other parts, usually indicates how the subcombination may effect a useful result. When this is so the combination need not be operative alone, because (to use the language of Mr. Walker) “utility is justly ascribed to things which have their use in co-operating with other things to perform a useful work.” In *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 309, 22 C. C. A. 203, 211, in considering the objection that the claims by themselves



were void, because not composing an operative mechanism, the court said: "The law upon this subject is too well settled to be open for discussion. A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve wheel does not affect the validity of either of the claims, which belong to that class where reference may be made to the specification to supply in a claim what is plain to any one skilled in the art." "

"To a similar effect, see *Canda et al. v. Michigan Malleable Iron Co.*, 124 Fed. 486, 61 C. C. A. 194, and *Clark Blade & Razor Co. v. Gillette Safety Razor Co.*, 194 Fed. 421, 114 C. C. A. 383."

This decision was affirmed by the Court of Appeals for the Second Circuit, 211 Fed. 654, the court saying:

"We are in full accord with the reasoning by which Judge Hazel reached the conclusion that the patent was valid and infringed."

In *Deering v. Winona Harvester Works*, 155 U. S. 286, the court in holding the patent there sued on valid and infringed, speaking through Mr. Justice Brown, said at page 302, in disposing of the defendant's contention there that the claim did not comply with the Revised Statutes:

"Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described be read into the claim."

In order to determine what is meant by "a control system" for an elevator car and switches within and without the car being "*operable*" to cause the stopping of the car at the respective landings it must be understood that the switches are connected through proper circuits to bring about the desired result. The use of the words "*operable*"

to cause" in claim 37 necessarily brings in these other operative features when considering the validity of the claim.

In *Chambers-Bering-Quinlan v. Faries*, 64 Fed. 587, (D. C. Ill.) Judge Allen, in holding the sub-combination claim there asserted valid and infringed, said at p. 588:

"The defense relied on for the sixth claim is that it is for an inoperative combination. Anticipation is not asserted. This objection is not well taken, as the law is well settled that a valid combination claim may be taken for a less number of parts than are required for the complete operation of a machine. *Forbush v. Cook*, 2 Fish. Pat. Cas. 668, Fed. Cas. No. 4,931; *Inspirator Co. v. Jenks*, 21 Fed. 911; *Jenkins v. Gurney*, 23 Fed. 898; *McDonald v. Whitney*, 24 Fed. 600."

In *Hancock Inspirator Co. v. Jenks*, 21 Fed. 911, (C. C. Mich.), Judge Brown in disposing of defendants' contention there that the claim asserted did not comply with the Revised Statutes, said at p. 915:

"Now, while it is entirely true that the combination stated in these claims would be obviously inoperative without such induction tube and chamber, still, by adding these elements, the construction would be equally inoperative without a boiler to furnish the steam and a well to supply the water, and a pipe leading to and from the boiler. But, in drawing the claims for a combination patent, we do not understand it to be necessary to include any elements except such as are essential to the peculiar combination, and are affected by the invention. Other portions of the machine are usually shown in the drawings to exhibit their relation to the patented combination, and they are wholly unnecessary to the validity of the claims. Indeed, it is manifest that the more elements introduced into the combination, the easier it would be to evade the patent; since, to sustain a suit for infringing a combination, it must be made to appear that the defendant used every element of such combination, however immaterial it may be. *Vance v. Campbell*, 1 Black, 429."

In *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301 (C. C. A. 3) the court in holding the claim there involved valid and infringed, said at p. 309:

“A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve whirl does not affect the validity of either one of the claims, which belong to that class where reference may be made to the specifications to supply in a claim what it is plain, to any one skilled in the art, is a necessary incident. *Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co.*, 10 C. C. A. 194, 61 Fed. 970; *Deering v. Harvester Works*, 155 U. S. 286, 15 Sup. Ct. 118. The decree of the circuit court is affirmed.”

In *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 Fed. 759 (C. C. A. 2) the court, in holding the sub-combination claim there sued on valid and infringed, said at p. 763:

“Many subcombinations, although new, are not useful, except to perform their appropriate functions in the machine of which they are a part. The description in the patent of the whole machine, and of the means or mode by which the subcombination is brought into co-operative relation with the other parts, usually indicates how the subcombination may effect a useful result. When this is so, the combination need not be operative alone, because (to use the language of Mr. Walker) ‘utility is justly ascribed to things which have their use in co-operating with other things to perform a useful work.’ In *Taylor v. Sawyer Spindle Co.*, 75 Fed. 301, 309, 22 C. C. A. 203, in considering the objection that the claims by themselves were void because not composing an operative mechanism, the court said:

“ ‘The law upon this subject is too well settled to be open for discussion. A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete com-

ination of the spindle and its supporting tube and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve wheel does not affect the validity of either of the claims, which belong to that class where reference may be made to the specification to supply in a claim what is plain to anyone skilled in the art.' "

Otis Elevator Company,  
*Plaintiff,* }  
*vs.* } In Equity  
 Pacific Finance Corporation, } No. M-25-J  
 and Llewellyn Iron Works, }  
*Defendants.* }

In making his recommendation as to the judgment to be entered herein, the Master concluded that the Parker Re-issue Patent No. 16,297, granted March 23, 1926, on a "control for electric elevators" owned by the plaintiff, and particularly claims 3, 22, 29, 40, 41 and 65 are good and valid; that claims 3, 22, 29, 40 and 65 thereof have been infringed by the defendants; and that claim 37 is invalid for indefiniteness under section 4888 of the Revised Statutes and claim 41 is not infringed.



Notwithstanding the fact that no findings have been made by this Court or any decree entered pursuant to the recommendations of the Master, the defendants notified the plaintiff that they would move for an order or decree dismissing this cause or an order directing such other proceedings herein as to additional pleadings and proofs as may be proper on the grounds

(a) That the Master found claim 37 of the Letters Patent in suit invalid under Section 4888 of the Revised Statutes.

(b) That thereafter plaintiff did not and has not taken nor attempted to take or preserve any exception to the finding of the Master that claim 37 is invalid.

(c) That plaintiff filed in the United States Patent Office a disclaimer as to claims 34, 35, 36, 37 of the Parker patent on May 1, 1931; that plaintiff thereby abandoned the validity of claim 37 and unreasonably neglected and delayed entering a disclaimer as to claim 37.

(d) That plaintiff was unlawfully holding itself out as possessor of the sole right to make, use and vend under said void claim 37, by notice to the public demanding that competitors desist from infringement of such claim.

(e) That by reason of plaintiffs unreasonable neglect and delay in disclaiming said claim 37, the said Parker patent in suit is wholly void as to any and all claims thereof.

At the outset, it should be borne in mind—

1. That the Parker patent relates to a very important invention used by the defendants and has been so found by the Master in his recommendations to this Court.

2. That no findings have been made or decree entered by this Court concerning the recommendations of the Master.

3. That the disclaimer as to claims 34-37 was filed May 1, 1931, before plaintiffs had any indication as to the character of the decree to be entered by the Court as to whether it would confirm the conclusion of the Master that claim 37 does not comply with section



4888 of the Revised Statutes and is invalid because its description of the result contained in this claim, without reference to the structure, cannot be read on the structure with sufficient accuracy to define the claim.

4. That the Master has not found that claim 37 is invalid because the patentee "claimed more than that of which he was the original first inventor or discoverer" but only because of indefiniteness, and because he "considered that the other claims amply protect the invention."

5. That, even if the Court had entered a decree confirming the Master's report, before the disclaimer of claim 37 had been filed, holding claim 37 invalid solely because it did not comply with section 4888 of the Revised Statutes, an appeal would lie to the Court of Appeals from a decree so holding, if this point of law had been urged by plaintiff before the trial court, as it would have been had the disclaimer not been filed, even though no specific exceptions were taken to the Master's report. The question of the validity of this claim arising solely from incompleteness in description, *is one of law* can be raised and argued in the trial court without taking an exception and may properly be reviewed by the Court of Appeals on appeal from whatever decree is entered relative thereto.

6. That the disclaimer was not a "*necessary*" one under the Statutes and decisions but one that could properly be filed at any time prior to expiration of the patent, solely at the option of the owner of the patent.

The patent in suit is directed to entirely novel mechanical and electrical co-operating controlling means, combined in an electric elevator, whereby under normal operation the starting of the car, either in up or down direction, is entirely, singly and only initiated through a switch manually operated from within the car, and the car automatically stopped at any number of predetermined floor levels by secondary control means initiated either from within the car or from any of the various landings.

The only claims asserted in this suit were 3, 22, 29, 37, 40, 41, and 65, all of which except 37 were held valid by the Master. In so holding (Master's Pr. Rep. p. 12), he said

“*Nothing in the prior art shows a combination of control means by which an elevator can be started by an operator and thereafter be stopped automatically at several landings in response to control means in the car and at successive landings in response to control means actuated at any time before the car reaches the selected landing.*”

and (p. 16)

“Parker’s automatic control has eliminated the difficulties which resulted from human error such as operator’s forgetting floor stops and passing waiting passengers. It also permits the use of less skilled operators and relieves the operator of the greater part of his former responsibility.”

and (p. 26)

“The invention of Parker is an important one.”

It is thus clear that the Master not only found that the Parker invention was an important one, but also that none of the combinations claimed or attempted to be claimed in any of the claims asserted is shown to be old or is to be found in the prior art.

Nevertheless, with respect to claim 37 the Master said—  
(p. 22, Printed Report)

“The circuits and circuit closing means are not included in the claim in any way even in general terms, such as the ‘means’ or ‘mechanism’ found in the other claims. *This description of the result without reference to structure cannot be read on the structure with sufficient accuracy to define the claim.* While the inclusion in a claim of language describing function or result does not render the claim invalid, nevertheless, *the claim must include such definition of structure that the elements of the structure claimed can be identified. It must also be considered that the other claims amply protect the invention.*

The plaintiff firmly believes and urged before the Master that claim 37 was a proper one and was sufficiently definite as a sub-combination claim to comply with Section

4888 R. S. under the authorities applicable\*. Notwithstanding this, before any finding of this Court was made or any final decree entered, plaintiff filed a "*proper*", but not "*necessary*" disclaimer as to claim 37, and others of the same general form not here asserted, because the rest of the claims of this Parker patent, more definite in terms, amply protect the invention.

In filing this disclaimer, plaintiff said—(See certified copy of disclaimer to be filed with the court):

"The sole reason for this disclaimer is that a Special Master, in the case of Otis Elevator Company *vs.* Pacific Finance Corporation and Llewellyn Iron Works, now pending in and undecided by the District Court of the United States, for the Southern District of California, Central Division, had advised, for reasons likewise applicable to claims 34, 35 and 36, in a report filed by him, that said claim 37 is invalid as not complying with Section 4888 of the Revised Statutes, and as he 'considered that the other claims amply protect the invention'."

The *sole reasons* given by the Master for holding, *as a proposition of law*, claim 37 invalid, is that the claim did not comply with section 4888 R. S. *as to form*, and that "*the other claims amply protect the invention*," and not that claim 37 was invalid in view of the prior art or because Parker "claimed more than that of which he was the original or first inventor or discoverer." The disclaimer shows on its face that it was filed because the Master had advised that claim 37 did not comply with Section 4888 R. S. and because "*the other claims amply protect the invention*," and not because plaintiff then believed, or now believes or admits, that Parker "claimed more than

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\* *Wright Co. v. Herring-Curtiss*, 204 Fed. 597 (Judge Hazel, D. C. N. Y.) aff. C. C. A. 221 Fed. 654; *Deering v. Winona Harvester Works*, 155 U. S. 286, 302; *Chambers v. Faries*, 64 Fed. 587, (Judge Allen); *Hancock v. Jenke*, 21 Fed. 911 (C. C. Mich. Judge Brown); *Taylor v. Sawyer*, 75 Fed. 301, 309 (C. C. A. 3); *Thomson-Houston v. Black River Traction Co.*, 135 Fed. 759 (C. C. A. 2).

that of which he was the original or first inventor or discoverer.”

It clearly appears from both the Master’s report and the disclaimer filed that a disclaimer was unnecessary. It was under the statutes a “proper” disclaimer that could be filed at any time at plaintiff’s election if it did not choose to longer urge claim 37, *as the other claims amply protect the invention.*

Defendants’ motion *does not and cannot allege* that claim 37 is invalid because the patentee claimed more than he was entitled to, or that the plaintiff delayed in filing a disclaimer after entry of a decree or judgment of a competent court so holding. It is thus clear that defendants’ motion raises no defense under the disclaimer statutes (Sections 65 and 71, Title 35, U. S. C.—R. S. Secs. 4917, 4922)\*.

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\* SEC. 65, Disclaimer. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has *claimed more than that of which he was the original or first inventor or discoverer*, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. (R. S. Sec. 4917).

“SEC. 71. Suit for infringement where specification too broad. Whenever through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee has, in his specification, *claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer*, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. (R. S. 4922)” (Italics ours).



The defense attempted to be raised by defendants' motion only applies to cases where the patentee "*claims more than that of which he was the original or first inventor or discoverer.*" In such a case, it is necessary that a disclaimer be filed to save the patent, but it is only after a final decree or judgment (or one accepted as final) of a competent court that the patentee's time for promptly filing such a disclaimer begins to run.

Even when a disclaimer becomes necessary the patentee cannot, under the authorities, be charged with delay until after the entry of a decree or judgment from which no appeal is taken, or one from which no further appeal is permitted.

A *necessary* disclaimer (*i. e.*, where a court of competent jurisdiction has entered a decree or judgment holding that the patentee has claimed more than that which he was the first to invent, from which no appeal has been taken), must not be confounded with a *proper* disclaimer (*i. e.*, one which may or may not be filed as the patentee elects).

Where a claim has been held invalid for lack of utility or indefiniteness as not complying with Section 4888 R. S., a disclaimer is "*proper*" but not "*necessary.*"

The Master in his report concluded that claim 37 of the patent in suit was invalid and recommended that the Court so decree

(a) *not because* Parker claimed "*more than that of which he was the original or first inventor or discoverer*";

(b) *not because* he claimed "*materially more than that of which he was the first to invent*";

(c) *not because* he claimed to be the first, original inventor or discoverer of a substantial part of a thing of which he was not the original or first discoverer, for the Master definitely found, as shown on the face of his report, "*that the other claims amply protect the invention,*"

but because he ruled, *as a question of law*, that claim 37 did not comply with Section 4888 R. S. as to form, for it

did not include "such definition of structure that the elements of structure claimed can be identified."

The report of the Master shows that a disclaimer was not necessary as he found, *as a matter of law*, that Parker did not claim anything more than he was entitled to but that claim 37 was indefinite although it related to a subject matter *he was entitled to protect and did invent*, and that the other claims amply protected the invention. The disclaimer filed May 1, 1931, was not "*necessary*," though "*proper*". It affords no ground for defendants' motion.

The finding of the Master that (p. 12, Printed Report)—

"*Nothing in the prior art shows a combination of control means by which an elevator can be started by an operator and thereafter be stopped automatically in several landings in response to control means in the car and at successive landings in response to control means actuated at any time before the car reaches the selected landing.*"

shows

(1) That the arrangement to which the *sub-combination* of claim 37 was directed is a sub-combination that is neither anticipated nor shown to be old by the prior art.

(2) That Parker by sub-combination claim 37 was not claiming or attempting to claim more than that of which he was the original and first inventor, and

(3) That the only reason the Master concluded that claim 37 was invalid and recommended that such a holding be included in the decree was because this claim was indefinite, and did not comply with Section 4888 R. S.\* and because the in-

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\* "SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions; and he shall *particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery*. The specification and claim shall be signed by the inventor."



vention attempted to be covered by it *was amply protected by the other claims* he recommended be held valid, which more definitely express the invention set forth in claim 37.

**UNDER THE STATUTES AND AUTHORITIES APPLICABLE A DISCLAIMER IS NECESSARY ONLY WHERE A PATENTEE HAS CLAIMED MORE THAN THAT OF WHICH HE WAS THE FIRST ORIGINAL INVENTOR OR DISCOVERER AND THIS DOES NOT HAVE TO BE FILED UNTIL AFTER THE ENTRY OF A FINAL DECREE BY A COURT OF COMPETENT JURISDICTION.**

Parker's claim 37 does not "claim more than that of which he was the first original inventor or discoverer." The Master very definitely found not only that "the other claims amply protect the invention", but that

"Nothing in the prior art shows a combination of control means by which an elevator can be started by an operator and thereafter be stopped automatically at several landings in response to control means in the car and at successive landings in response to control actuated at any time before the car reaches the selected landing."

It was to such a combination that the claims asserted, including the sub-combination claim 37, were directed.

The sole reason for the Master's conclusion and recommendation that claim 37 be held invalid by decree of this Court is because he concluded, erroneously, we think, that the sub-combination there claimed was indefinite and for that reason only did not comply with Section 4888 R. S. Section 4888 of the Revised Statutes requires, among other things, that the patentee—

"shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

In the present case the Master, in recommending that a decree be entered holding claim 37 invalid, said (p. 22 Pr. Rep.):

“The circuits and circuit closing means are not included in the claim in any way even in general terms, such as the ‘means’ or ‘mechanism’ found in the other claims. This description of the result without reference to structure cannot be read on the structure with sufficient accuracy to define the claim. While the inclusion in a claim of language describing function or result does not render the claim invalid, nevertheless, the claim must include such definition of structure that the elements of the structure claimed can be identified. It must also be considered that the other claims amply protect the invention. It is concluded that Claim 37 does not comply with Section 4888 of the Revised Statutes and is, therefore, invalid.”

The Supreme Court in *Cartridge Co. v. Cartridge Co.*, 112 U. S. 624, in considering the disclaimer statutes and laying down the rule as to when disclaimers are necessary, speaking through Mr. Justice Blatchford, said at p. 642:

“It is a patentee who ‘*has claimed more than that of which he was the original or first inventor or discoverer,*’ and only ‘*such patentee,*’ or his assigns, who can make a disclaimer; and the disclaimer can be a disclaimer only ‘*of such parts of the thing patented as he shall not choose to claim or hold by virtue of the patent or assignment.*’ A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a claim in respect to the thing so not originally or first invented. It is true, that, in so disclaiming or limiting a claim, descriptive matter on which the disclaimed claim is based, may, as incidental, be erased, in aid of, or as ancillary to, the disclaimer. *But the statute expressly limits a disclaimer to a rejection of something before claimed as new or as invented, when it was not new or invented, and which the patentee or his assignee no longer chooses to claim or hold.* It is true that this same end may be reached by a reissue, when the patentee has claimed as his own invention more than he had a right to claim as new, but, if a claim is not to be rejected or limited, but there is merely ‘*a defective or insufficient specification,*’ that is, description, as distinguished from a claim, the only mode of correcting it was and is by a reissue.”

The Supreme Court has since repeatedly cited this case with approval.

In *Carson v. American Smelting Co.*, 4 Fed. (2) 463, the Court of Appeals of this Circuit has recognized and followed the ruling laid down by the Supreme Court in *Cartridge Co. v. Cartridge Co.* case. In dealing with the disclaimer involved, it said at page 469:

“It is intended for the protection of the patentee as well as the public, and ought not, therefore, to receive a construction that would restrict its operation within narrower limits than its words fairly import.’ In *Cartridge Co. v. Cartridge Co.*, 112 U. S. 624, 642, 5 S. Ct. 475, 485 (28 L. Ed. 828), it was said: ‘A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a claim in respect to the thing so not originally or first invented.’ Said the court in *Sessions v. Romadka*, 145 U. S. 29, 40, 12 S. Ct. 799, 801 (36 L. Ed. 609): ‘The power to disclaim is a beneficial one, and ought not to be denied, except where it is resorted to for a fraudulent and deceptive purpose.’”

Walker on Patents, Fifth Edition, p. 265, Section 195, says—

“Mistakes of fact, relative to how much of a described process, machine or manufacture was first invented by its patentee, frequently follow from lack of full information touching what was previously invented by others. Litigation may alone disclose the fact that the patentee’s claims are too numerous or too broad to be consistent with novelty. Whenever this occurs, it is clear that the patentee ought no longer to appear to hold an exclusive right to anything which he was not the first to invent. To this end, the statute provides that he must disclaim that part, within a reasonable time, or, in default thereof, must suffer the statutory consequences. On the other hand, it is equally clear, that if the patentee is willing to eliminate from his claims, everything which later information shows *had been invented before him*, he ought to be allowed to retain his exclusive right to the residue. To this end,

*the statute provides that if within a reasonable time, he disclaims what was another's, he shall be enabled to enforce his patent as far as it covers what was his own invention. But a disclaimer cannot confine claim to ground which does not appear in the patent to constitute an invention; even where that ground is narrower than that which was originally claimed in the patent."*

In a very recent case, *Sachs v. Hartford Electric Supply Co.*, 47 Fed. (2) 743 (C. C. A. 2), Circuit Judge Learned Hand, in dealing with a disclaimer filed to limit the claims, said at p. 747:

"However, we do not see that these limitations were in any sense *necessary* to escape the prior art. *A disclaimer is to abandon some part of the invention of which the patentee is not 'the first and original inventor'. If he has claimed originally too much, so that the claims are invalid under the prior art, the part disclaimed must be clearly separate in the body of the specifications; if he wishes to recast the whole, he must go to a reissue. But there is no objection to his limiting a valid patent as his fears may dictate; \* \* \** It is a timorous retreat from positions which he could have successfully maintained."

**THE FAILURE TO FILE A PROPER BUT UNNECESSARY DISCLAIMER IS NOT INJURIOUS TO THE REMAINING CLAIMS UNDER THE STATUTES AND AUTHORITIES APPLICABLE, BUT MAY BE FILED ANY TIME BEFORE THE EXPIRATION OF THE PATENT AT THE PATENTEE'S ELECTION.**

The disclaimer statutes and authorities only *require* a disclaimer when the "patentee has claimed more than that of which he was the first and original inventor." Such a disclaimer is called a "*necessary*" disclaimer because it is imperative that it be filed without unreasonable delay after final judgment or decree of a competent court holding it invalid in order to save the remaining claims. A disclaimer which does not fall within that requirement is not a "*necessary*" one and may or may not be filed at the patentee's election, but it is a "*proper*" disclaimer. To illus-



trate, when a claim has been held invalid, even in a final decree, solely for lack of utility or solely because it is indefinite, and does not comply with Section 4888 R. S., no disclaimer is necessary or required, but in such a case a disclaimer may properly be filed if and whenever, the patentee so elects. The remaining claims are affected only where the disclaimer was “*necessary*”.

Robinson on Patents, in dealing with “*proper*” though not “*necessary*” disclaimers, says, Vol. 2, page 293, section 652:

“A disclaimer filed without sufficient cause is a nullity under this as well as the former section of the act. If there is no real excess of Claim, according to the construction given to its language by the Court, the filing of a disclaimer by the plaintiff, pending suit, does not admit his inability to recover costs. A disclaimer leaving the patent to claim the entire invention, as the courts must have construed it had the disclaimer not been filed, is equally inoperative both as an amendment and upon the costs. The same is true of a disclaimer of a part or act not claimed in the patent, and of such features as the court finds merely formal and not essential to the idea of means embodied in the invention as originally claimed.”

Here the Master construed the claims he recommends be sustained as covering the invention attempted to be covered by the sub-combination of claim 37, for he definitely stated as one of his reasons for advising, as a proposition of law that claim 37, was invalid—

“that the other claims amply protect the invention.”

Therefore, under the statement of Robinson in his work on Patents a disclaimer was wholly unnecessary here and need not have been filed. It was filed only because the owner of the patent elected to file it to save further controversy and expense over it, and not because it was obliged to do so under the statutes or decisions.

Walker on Patents, Sixth Edition, quoted with approval



by the Supreme Court in the *Ensten* case, *infra*, on which the defendants here mainly rely, stating, page 334, Section 248, in dealing with unnecessary disclaimers:

“There appears to be no warrant in the statute, for disclaiming any claims which is void for want of utility, and for no other cause. An inventor of a new thing may generally ascertain its character in point of utility before applying for a patent. If he can do so, he ought to do so, and thus shield the public from a waste of time involved in examining and judging useless contrivances. Where a patent has but one claim, and where the matter covered by that claim is useless, no disclaimer could make that patent valid. Where a part only of the claims of a patent are void for want of utility, and for no other cause, the void claims are not injurious to the valid ones, and therefore no disclaimer is needed in any such case.

“And no disclaimer is necessary where some, but not all of the claims of a patent are void, by reason of constructive abandonment, resulting from public use or sale of the subjects of those particular claims, more than two years prior to the application for the patent.”

Again Walker says (p. 341):

“The case where a disclaimer is necessary to save the patent *must, however, be distinguished from the case where a disclaimer would be merely proper, as, for instance where a claim is invalid for incompleteness of description, as in the latter case the foregoing rule as to costs does not apply.*”

Again Walker says (p. 337, Section 251):

“There is one difference between the two disclaimer sections of the Revised Statutes, which it is proper to mention and explain in this place. Section 4917 contemplates disclaimers as being proper whenever a patentee has claimed more than that of which he was the first inventor; while Section 4922 attends only to cases wherein the excess is a material or substantial part of the thing patented. This qualification should be inserted in the two sections as construed together because Section 4922 is the only one that prescribes any evil result from a failure to disclaim. Neither section

visits any infliction on the patentee, for omitting to disclaim anything which is an *immaterial part* of the thing patented. If, therefore, a patentee omits to disclaim such a part when he discovers it to have been known before his invention thereof, or learns that it is not an invention at all, he thereby loses no right, and incurs no inconvenience. To file a disclaimer, in such a case, is an act which is at once harmless and unnecessary."

In the pending case, if the Master is right in concluding that claim 37 of the Parker patent is indefinite and incomplete and failed to comply with Section 4888, then it never was a claim which covered an invention. It merely amounted to a paragraph of immaterial reading matter which need not, but may be, disclaimed. According to Walker—

"To file a disclaimer, in such a case, is an act which is at once harmless and unnecessary."

In *National Electric Signaling Co. v. DeForest Wireless Telegraph Co. et al.*, 140 Fed. 449, (C. C. S. D. N. Y.) Judge Wheeler in distinguishing between "*necessary*" and "*proper*" disclaimers and dealing with a situation where a claim is invalid for "*indescription*", said at page 455:

"The statutes restricting costs upon filing a disclaimer after suit seems only to apply where a disclaimer is necessary to upholding the patent, and is filed for the purpose of saving it. That is not the situation here. No part of the invention set forth to which the claims held valid apply needs to be disclaimed to make or leave them valid. *The doubt about those in question not held to be valid arises from their description of what is claimed, and not from failure of right of the patentee to what they might have covered. The various forms of claims for the same thing need not all be valid; and those that for indescription are not valid need not be disclaimed in order to recover upon those that describe the actual invention. That costs were not mentioned was not intended to indicate that they should not follow the recovery.*"

"The decree is made to conform to these views."

Judge Wheeler thus clearly held that a claim which was invalid for incompleteness or indescription, both meaning the same thing, need not be disclaimed, that is, such a situation does not require or make "necessary" a disclaimer. This is precisely the condition in the present case.

In *Marconi Wireless Telegraph Co. v. DeForest Radio Telephone & Telegraph Co.*, 243 Fed. 560, (C. C. A. 2nd, Cox, Rogers and Hough, Circuit Judges) Circuit Judge Hough in delivering the opinion of the Court, in disposing of the contention there made that the patent in suit was made void by an unlawful disclaimer, said (p. 565):

"The mistake (if there was one) was in claiming something not needed, and the disclaimer abandoned what was not wanted, without broadening or enlarging any claim; it also left the claims fully supported by the original specification. No injury to defendant, or any one else, is shown."

The Court of Appeals for the Ninth Circuit in *Carson v. American Smelting & Refining Co.*, 4 Fed. (2) 463, *supra*, at p. 470, speaking through Circuit Judge Gilbert, adopted and quoted the above language of Judge Hough with approval.

In the present case, if we follow the Master's report, the mistake (if there was one) was in attempting to cover a sub-combination by claim 37, which was not needed because he states "the other claims amply protect the invention."

The scope of the sustained claims of the Parker patent is not affected by the proper but not necessary disclaimer of claim 37. There is no injury to this defendant, which has infringed the Parker patent, or anyone else, by the canceling of a claim which is said to be so indefinite as to be improper under Section 4888 R. S. This is especially so where, as here, there can be no contention that claim 37 is met by the prior art or that the "patentee claimed more

than that of which he was the original or first inventor or discoverer.”

In *Whitney v. Boston & A. R. Co. et al.*, 50 Fed. 72, (C. C. Mass.) Judge Nelson said:

“Defendants’ motion to withhold a decree in favor of the plaintiff until the plaintiff shall have disclaimed the 1st, 4th, 5th, 6th and 7th claims of his patent is denied, upon the ground that, assuming, as the defendants contend, that the evidence in the case proves that said claims cover what had been in public use and on sale for more than two years prior to the plaintiff’s application for his patent, yet, since it appears that the plaintiff was the original and first inventor of the parts of his invention secured by said claims, he is therefore not required by Rev. St. sec. 4922, in order to entitle himself to a decree for an infringement of the second and third claims of his patent, to make disclaimer of the other claims.”

The courts have repeatedly refused to insist on disclaimers even where the evidence shows that claims *not in suit* were invalid in view of the prior art.

We have found no cases where any court required a disclaimer where one of the claims sued on was held invalid for an incomplete description or indefiniteness, or lacking in utility, that is, did not comply with Section 4888 R. S.

It is clear under the statutes and authorities that a disclaimer was not “*necessary*” in the present case but that the one filed is “*proper*” and one that may or may not have been filed at plaintiff’s election without any injurious results to the sustained claims.

**THE ENSTEN CASE, 282 U. S. 445, UPON WHICH DEFENDANT RELIES, DOES NOT SUPPORT DEFENDANTS’ MOTION. IT DOES NOT APPLY TO THE SITUATION HERE.**

Bearing in mind that the “*proper*” though not “*necessary*” disclaimer of claim 37 of the Parker patent in suit, as well as claims 34, 35, 36 not relied upon, was filed while



this Court had the Parker patent under advisement for its determination and before any findings of fact were filed or any decree entered by it, and that an appeal would lie to the Court of Appeals of this Circuit, if a decree should be entered confirming the finding of the Master that claim 37 was invalid, and plaintiff had insisted on a ruling as to the legal conclusion as to the validity of claim 37 instead of filing a disclaimer of it, we submit that defendants' motion should be over-ruled and that the case of *Ensten v. Simon, Ascher & Co.*, 282 U. S. 445, is no authority for the sustaining of defendants' present motion in the instant case.

In the *Ensten* case, the patent contained six claims which were asserted in the Northern District of Ohio (*Ensten v. Rich-Sampliner Co. et al.*). An interlocutory decree was filed May 24, 1922, that adjudged claims 1, 3, 4 and 5 valid and infringed and held claim 2 invalid in view of the prior art. In other words it was held as too broad and included more than that of which "the Patentee was the original or first inventor or discoverer." Within thirty days the defendants appealed from so much of the decree as upheld the four claims. Complainant might have, but did not appeal, from that portion of the decree holding claim 2 invalid, in view of the prior art, and hence the validity of claim 2 was not before the Court of Appeals when it approved the decree so far as challenged by the defendants as to claims 1, 3, 4, 5. The plaintiff, not having appealed from the holding that claim 2 was invalid, as claiming more than that of which he, the Patentee, was the original or first inventor or discoverer, and the Court of Appeals having affirmed that decree, the plaintiff was thereby prevented from ever again asserting in that suit the validity of claim 2.

Notwithstanding no appeal was taken from the interlocutory decree of May 24, 1922, the plaintiff waited until



April 30, 1924, to file a disclaimer as to claim 2 in the Patent Office.

Judge Westenhaver in the case of *Ensten v. Simon, Ascher & Co.*, (38 F. (2) 71), and the Court of Appeals of the Sixth Circuit, held that the patentee had unreasonably neglected and delayed disclaiming claim 2 after the District Court in Ohio had decreed it invalid, from which decree no appeal was taken.

The Supreme Court in the Ensten Case quotes from the opinion of *O'Reilly v. Morse* (1853) 15 How. 62, as follows (p. 454):

"It appears that no disclaimer has yet been entered at the Patent Office. But the delay in entering it is not unreasonable. For the objectionable claim was sanctioned by the head of the Office; it has been held to be valid by a Circuit Court and differences of opinion in relation to it are found to exist among the justices of this court. *Under such circumstances the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment.*

Again the Court says (p. 455):

"In certain definitely defined circumstances, and to the end that the mistaken but honest inventor may obtain relief from the old rule, the disclaimer provisions permit him to deprive the public temporarily of complete freedom from the assertion of a monopoly apparently valid, but not so in fact. *When a competent court had declared his pretensions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit either to vindicate his position or to relieve the public from further evil effects of his false assertion.*

And again the Court says (p. 455):

"When the District Court in Ohio declared claim 2 invalid, the owner of the patent might have appealed to the Circuit Court of Appeals within thirty days and thus secured an early determination of his rights. He did not choose this course but continued to hold him-

self out as possessor of the sole right to 'make, use and vend' under the rejected claim, for nearly two years. Then he abandoned it. He made no effort promptly to vindicate what he had asserted nor did he surrender it. Thus he failed to earn the offered exemption and now he may not complain."

Again on page 457, the court says:

"Certainly, in this case where an appeal was taken by the defendants, it would have entailed no unreasonable hardship upon the patent owner promptly to have submitted the legality of the rejected claim for determination by the appellate court. The route to that end was obvious, easy, inexpensive. He deliberately failed to defend his assertion of right by appealing. He has been guilty of unreasonable delay and has not brought himself within the beneficent provisions of the statute."

The opinions in the Ensten cases show conclusively that claim 2 of the patent there involved was decreed invalid *in view of the prior art*; therefore, the patentee had "claimed more than that of which he was the original or first inventor or discoverer." This decree having been entered and an appeal having been taken to the Court of Appeals by the defendant as to the validity of claims 1, 3, 4 and 5, within the time allowed for appeal from an interlocutory decree, and the plaintiff having taken no appeal from the interlocutory decree holding claim 2 invalid in view of the prior art, the decree of the trial court became final as to claim 2 and the patentee was thus under the immediate obligation of filing disclaimer if he desired to maintain the rest of his patent under the disclaimer statutes. Such a disclaimer was "necessary" under the statutes and decisions. The patentee filed no such disclaimer of claim 2 for nearly two years and under these circumstances the trial court, Court of Appeals, and the Supreme Court held the patent invalid because of failure to promptly file the disclaimer.

In the instant case, no such situation exists as in the Ensten case referred to for the following reasons:

In the instant case—

1. Claim 37 of the Parker patent does not claim more than that of which Parker was the original or first inventor or discoverer nor “materially more than that which he was the first to invent.”

2. The Master recommended that claim 37 drawn to a sub-combination be decreed invalid only because it was indefinite and hence did not comply with Section 4888 R. S. and because he “considered that the other claims amply protect the invention.” There is not possible interpretation of the Master’s report that Parker by claim 37 claimed more than that of which he was the original or first inventor.

3. There were no findings by this court nor any decree entered by it holding that claim 37 of the Parker patent was invalid at the time the disclaimer was filed nor has there been any indication as to any such findings or decree up to the present time.

4. Had not plaintiff filed a disclaimer of claim 37 prior to the entry of a decree by this court confirming the Master’s report and thereby holding claim 37 invalid, the plaintiff was at liberty to have raised and argued, without taking an exception, the legal conclusion as to whether claim 37 was valid under section 4888 of the Revised Statutes and could have appealed from that portion of any decree holding claim 37 invalid. Therefore, as stated by the Supreme Court, 282 U. S. 453,

“The allowance of his claim by the patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides it is broader than his real invention.”

and page 454:

“The patentee had a right to insist upon it and not disclaim it until the highest court to which it could be carried had pronounced its judgment.”

5. The mere failure to file exceptions to a Master’s report, on a conclusion of law, does not prevent the party not taking exceptions, from raising and arguing a question of law such as that involving the question

of whether a claim complies with Section 4888 R. S. or not, nor does it prevent his having the Court of Appeals thereafter review the decree of the District Court thereon.

6. Until a decree has been finally entered holding a claim invalid and this decree has either been affirmed by the highest court to which an appeal is taken or no appeal taken within the time permitted by statute, a patentee who has had a claim allowed to him is under no obligation to file a disclaimer to that claim under the Federal Statutes, even where he claims more than that of which he was the original or first inventor or discoverer.

7. Parker, having claimed no more than that of which he was the original or first inventor or discoverer, was under no obligation to file any disclaimer of claim 37, even though the Master recommended that a decree be entered holding this claim invalid because of indefiniteness and that the other claims amply protect the invention. It was unnecessary for him to do so.

8. Parker, having filed a proper disclaimer of claim 37, even though he was the inventor of the subject-matter thereof, was not required by any statute to do so in order to maintain his patent.

9. The owner of the Parker patent cannot be charged with any delay in the entering of the final decree in this case or in the filing of a disclaimer of anything it saw fit to disclaim prior to the entry of a decree or failure to appeal therefrom.

10. A Master's report is only advisory *on questions of law* such as is involved in his recommendation for a decree as to claim 37.

11. There is no possible theory on which delay could be predicated, even though the situation in the present case required a "*necessary*" disclaimer, which it does not.

12. The Federal Statutes do not require any disclaimer whatsoever unless "*the patentee has claimed more than that of which he was the original or first inventor or discoverer.*" This Parker has not done nor has the Master so held. Under such circumstances, Parker was entitled to file his "*proper*" though not "*necessary*" disclaimer when he did or in fact at any time prior to the expiration of his patent, if he so desired. Even in the Ensten case, upon which the de-



fendants solely rely, the Supreme Court clearly recognized that the time for filing even a necessary disclaimer does not start to run until a court of competent jurisdiction has entered a decree or judgment from which an appeal can be taken holding that "the patentee claims materially more than that of which he was the original or first inventor" and also that he should not even then be required to disclaim it "until the highest court to which it could be carried had pronounced its judgment."

**THE EXCEPTION TO THE GENERAL RULE IS THAT NO EXCEPTIONS NEED BE FILED TO THE LEGAL CONCLUSIONS OF A SPECIAL MASTER.**

In *Central Improvement Co. v. Cambria Steel Co.*, 210 Fed. 696, 699 (C. C. A. 8) the general rule is that—

"Where no exception is taken to the master's report it will be deemed to be true, and where exceptions to parts of it are taken the parts to which no exception is taken will stand as correct and will not be open to review in an appellate court",

but that—

"This rule, like most rules of law or practice, is not without its exceptions",

and refers to *Sheffield v. Gordon*, 151 U. S. 285, 291, where the Supreme Court said:—

"It is true that if the report of the Master is clearly erroneous in any particular, it is within the discretion of the court to correct the error,"

The Court of Appeals in the Cambria case further said (p. 700):

"In 2 Daniell's Chancery Pleading and Practice, at page 1314, it is said that it is entirely discretionary with the court to grant an opportunity to except to a report after it has been absolutely confirmed \* \* \* suits in chancery are tried and reviewed in view of the fact that a court of equity has and frequently exercises the power where justice may thereby be done, to grant to litigants the right remedy although they have sought the wrong one. \* \* \* As an appeal in equity in the Federal Courts results in a trial *de novo*, the

appellate court is not, in our opinion, so powerless that it is compelled to affirm an unjust decree; nor is the appellant so conclusively estopped that it may not attack such a decree by the fact that it gave a wrong reason for its exception to the erroneous conclusion of the master it assails."

In *Burke v. Davis*, 81 Fed. 907, the Court of Appeals for the Seventh Circuit considering a case where no exceptions are filed by the complainant and their motion thereafter made for leave to file exceptions being denied, nevertheless considered the case without exceptions and reversed the decree of the District Court. On the question of want of exceptions to the master's report, the Court said:—(p. 910)

"In the absence of exceptions to the report there can be no inquiry into the correctness of the master's findings of fact; but whether the proper decree was entered upon the report is nevertheless open to consideration. The master's mistaken apprehension of the legal consequences of the facts reported, as Daniell stated it, 'may be opened to further directions, without exceptions'."

In *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 40 Fed. 476, C. C. N. Y., the case came on for argument on exceptions to the master's report. The defendant took no exceptions as to certain *findings of fact*, and Circuit Judge Wallace held that these findings, therefore, should not be disturbed. However, as to the practice as to *conclusions of law* where no objections were filed, the Court stated (p. 477):—

"The practice thus referred to does not preclude the defendant from being heard upon a question of the correctness of the legal conclusion reached by the master. Where the master, by his report, states the facts correctly, but errs as to the legal conclusion, the party against whom he errs is not required to except to the report, but may bring the question to the attention of the court upon further directions; or, if the report is made pursuant to an interlocutory decree, when the cause comes on to be disposed of by a final decree. 2 Daniell, Ch. Pr. 149. The cause remains under the

control of the court until disposed of by a final decree, and until then it can revise the interlocutory decree, or any proceeding in the cause; and it is its duty to correct any error of the master affecting the merits, as well as any error of its own, properly brought to its knowledge. *Vooster v. Handy*, 22 Blatchf. 308, 21 Fed. Rep. 51; *Perkins v. Fourniquet*, 6 How. 206; *Fourniquet v. Perkins*, 16 How. 82."

In *Smith v. Seibel*, 258 Fed. 454, D. C. Iowa, as no exceptions to the Master's report were filed within the twenty days permitted, the Court, District Judge Reed, held (p. 456):—

"as no exceptions were filed thereto within 20 days, the report *as to the facts*, under equity rule 66, stands confirmed, and the defendant is precluded from urging the question thus raised as against the finding of the facts by the master. But the legal conclusion of the master upon *the facts so found appears* upon the face of the report, and *may be noticed by the court.*"

In *National Folding-Box & Paper Co. v. Dayton Paper Novelty Co.*, 91 Fed. 822 (C. C. Ohio), the late Mr. Chief Justice Taft, sitting as Circuit Judge, in disposing of an attack made on the propriety of the Master withdrawing after formally filing, and then correcting, revising and re-filing his report, said (p. 824):—

"Nor is there anything in the eighty-third equity rule which prevents action of the court upon the report of the master, summary, discretionary, or otherwise. That rule simply prescribes the course of the master in respect of filing the report, and of the parties in presenting exceptions; but it leaves the course to be taken by the court to be determined by practice in the high court of chancery in England as it was in 1842.

"It is insisted that the master, when he filed his report, became *functus officio*, and could not thereafter amend his proceedings, at a time when he was clothed with no official authority. This is the significance of the references to the 'ex-master' of which counsel's brief is so full. It will hardly be denied that the authority which the master exercised in his first report

came wholly from the court. It would seem clear that the court which gave him original authority might renew that authority. Re-references and recommitments are not so unusual as to require citations of precedents to justify them, and yet they can only be made on the theory that the court which originally conferred authority may renew it. The order of this court giving the master leave to withdraw his report for amendment necessarily gave him the authority to make an amended report, and he was as much master of the court when he made the second report as when he made the first.

“Mr. Justice Bradley, in *Thomson v. Wooster*, 114 U. S. 104, 112, 5 Sup. Ct. 788, speaking for the supreme court, said that the English edition of Daniell's Chancery Practice, published in 1840, contained the best exposition of the practice of the high court of chancery at the time the equity rules were adopted by the supreme court, and that to this book reference should be had when questions of federal equity practice arose which were not covered by the equity rules. In the edition of Daniell referred to, on page 961, is the following:

“‘Although the usual course by which a review of a master's report is to be procured is by taking exceptions to it, there are many cases in which the court will direct the master to review his report without requiring exceptions to be taken, or, if they are taken, will direct it to be reviewed upon grounds independent of those laid by the exceptions; and sometimes, as we have seen, the court will direct a master to review his report in order to afford a party an opportunity for taking in objections to the draft, as a foundation for exceptions. A reference back to the master, to review a report which has not been excepted to, may be made upon the hearing for further directions, and is frequently so made when the court is not satisfied with the master's finding, as where the master has not found sufficient facts for the court to found its judgment upon. So, also, if the master has exceeded his authority, it will either direct him to review his report, or take no notice of his finding.’

“See, also, 2 Beach. Mod. Eq. Prac. Sec. 713.



“In *Mosher v. Joyce*, 6 U. S. App. 107, 112, 2 C. C. A. 324, 325, 51 Fed. 441, 444, Mr. Justice Jackson, then circuit judge, speaking for the court of appeals of this circuit, said:

“‘In respect to such matters as the recommitment of accounts or a reference back to a master, the chancellor exercises a very large discretion, and is not to be put in error in his action upon such motions except upon a very clear showing of merits, and in the absence of negligence.’

“The right and power of the court to permit the master, upon his own application, to withdraw his report for amendment, would seem to be sustained by the following Massachusetts authorities: *Heywood v. Miner*, 102 Mass. 466; *Webber v. Orne*, 15 Gray, 351; *Gardner v. Field*, 5 Gray 600.”

We understand that the defendants intend that under the case of *Riverside Heights Orange Growers Assn. v. Stedler*, 240 Fed. 703, C. C. A. 9th, that the rulings of the Master where no exception has been taken will be given the same force and effect as a decree of the trial court, but a reading of the complete opinion in that case fails to disclose any such holding.

In that case appellees contended that certain of appellant's assignments of errors were defective in that they raised objections to the Master's report which were not presented to or considered by the lower court. In connection with the assignments of error, Circuit Judge Morrow said (p. 706):—

“Other than this, there is no answering argument made by appellee with respect to the questions discussed in appellants' brief under these assignments. It is a well-settled rule of law that:

“‘Exceptions to reports of masters in chancery are in the nature of a special demurrer, and the party objecting must point out the error; otherwise, the part not excepted to will be taken as admitted.’ *Story v. Livingston*, 13 Pet. 359, 366, 10 L. Ed. 200 (citing *Wilkes v. Rogers*, 6 Johns. (N. Y.) 566). ‘A party neglecting to bring in ob-

jections cannot afterwards except to the report.' Id.; *McMicken v. Perin*, 18 How. 507, 510, 15 L. Ed. 504. 'Proper practice requires that objections to a master's report shall be taken in that (the trial) court, *that any errors discovered therein may be rectified by the court itself*, or by a reference to the master for a correction of his report, without putting parties to the delay and expense of an appeal to this court.' *Topliff v. Topliff*, 145 U. S. 156, 173, 12 Sup. Ct. 825, 832 (36 L. Ed. 658).

“\* \* \* There is nothing in the record to show that any of the points now urged by appellant under the second and third assignments were ever presented to or considered by the lower court, and this court will not review a master's report upon objections taken here for the first time.”

It is obvious from the quoted portions that the court had in mind the *general* rule that exceptions should be taken to the Master's report. It is equally obvious that it also had in mind the *exception* to the general rule that no exceptions need be taken to errors at law but that the court itself may rectify such errors. This is clearly shown by the underlined portion quoted from *Topliff vs. Topliff*.

All that the Court of Appeals held in the *Riverside* case so far as the point relied upon by defendants is concerned is that objections to the Master's report cannot be urged for the first time upon an appeal to the Circuit Court of Appeals. With the proper understanding of the decision in this case, it is at once apparent that it is not applicable to the situation presented by defendants' motion to dismiss.

**THE FILING OF A DISCLAIMER IS NOT A CONFESSION THAT A PATENT WOULD BE VOID IF THE DISCLAIMER WERE NOT MADE.**

See: *Manhattan General Const. Co. v. Helros-Upton Co.*, 135 Fed. 785, 802 (C. C. Pa.); Walker on Patents, Sixth

Ed. p. 342, Sec. 258; *Bay State Optical Co. v. Klein*, 20 Fed. (2) 915, 917; *Permutit Co. v. Wadham*, 13 Fed. (2) 454, 457.

In the latter case the Court of Appeals, speaking through Circuit Judge Denison, stated at p. 457 :

“We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not affect the real value of his patent, and to make it will save trouble and expense and do no harm. We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter; and it has been so held. *Manhattan Co. v. Helios Co.*, 135 F. 785, 802.”

#### CONCLUSION.

In view of the foregoing facts and authorities applicable, defendants' motion does not and cannot set up a defense under the disclaimer statutes and should, therefore, be overruled.

Respectfully submitted,

WALLACE R. LANE,  
CLARENCE J. LOFTUS,  
RAYMOND IVES BLAKESLEE,  
*Counsel for Plaintiff.*

**"EXHIBIT C."**

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**DEFENDANTS' EXCEPTIONS TO MASTER'S REPORT INVOLVING  
CLAIM 37.**

30. The Master erred in sustaining the Reissued Letters Patent in suit in effect to cover merely the function or abstract effect of a machine without limiting the patent to the means or machine disclosed therein to produce that function or effect.

31. The Master in sustaining the Reissued Letters Patent in suit has erred in holding that the patent may be held valid merely for a principle or for an idea.

32. The Master in sustaining the Reissued Letters Patent in suit erred in failing to apply the settled rule of patent law that a patent cannot issue for an idea but only for the means by which the idea is embodied in an operative mechanism.

33. The Master erred in sustaining the Reissued Letters Patent in suit and finding infringement thereof because his decision is predicated in fact upon the proposition that by the patent in suit plaintiff can monopolize every means of performing the functions of starting the car from within the car by a manual switch and stopping the car automatically from either buttons within the car or buttons at the hall landings and this proposition is fundamentally unsound it having been uniformly held that no one can have a patent for the function or abstract effect of a machine, but only for the machine which produces it.

61. The Master erred in failing to find that if claims 37, 40, 41 and 65 or either thereof of the Reissued Letters Patent in suit are construed broadly enough to include the defendants' Pacific Finance elevators, each of the same



is anticipated by the patent to Strohm, Exhibit X-10, for the Strohm patent discloses means for separating down and up push button circuits by withdrawing the shoes G.

76. The Master erred in failing to find that Claims 29 and 37 including both car and hall buttons are void for aggregation, the hall and car buttons being functionally indifferent to each other.

99. The Master erred in not finding that Claims 37, 40, 41 and 65 of the Parker Reissued Letters Patent were deliberately and intentionally restricted to separate up and down car buttons and therefore could not be interpreted to include a system embodying only a single set of car buttons for both up and down direction.

111. The Master erred in failing to find that the claims of the Reissued Letters Patent in suit are for a different invention than that claimed in the original of said letters patent.

115. The Master erred in failing to find that the bill of complaint in this case should be dismissed as to Claims 22, 29, 37, 40, 41 and 65 because of the intervening rights of defendant Llewellyn Iron Works.

122. The Master erred in failing to find that the application for the reissue of the letters patent in suit was unreasonably delayed and that said reissued letters patent are for that reason invalid.

